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| APPLICATION NO.                        | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/031,360                             | 05/10/2002  | Koichi Komoda        | 967 023             | 2576             |
| 20874                                  | 7590        | 04/15/2008           | EXAMINER            |                  |
| MARJAMA MULDOON BLASIAK & SULLIVAN LLP |             |                      | HASAN, SYED Y       |                  |
| 250 SOUTH CLINTON STREET               |             |                      | ART UNIT            | PAPER NUMBER     |
| SUITE 300                              |             |                      | 2621                |                  |
| SYRACUSE, NY 13202                     |             |                      |                     |                  |
| MAIL DATE                              |             | DELIVERY MODE        |                     |                  |
| 04/15/2008                             |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/031,360             | KOMODA, KOICHI      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | SYED Y. HASAN          | 2621                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 January 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 6, 10, 13, 18, 21 - 23, 26, 29, 42 and 82 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 6, 10, 13, 18, 21 - 23, 26, 29, 42 and 82 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 07/09/2002, 06/07/2004, 06/10/2004, 09/13/2004  
and 04/08/2005.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.



## **DETAILED ACTION**

### **Response to Arguments**

1. Applicant's arguments with respect to claims 6, 10, 13, 18, 21, 22, 23, 26, 29, 42 and 82 filed on 01/10/2008 have been considered but are moot in view of the new ground(s) of rejection.

Kamibayashi et al (US 6847950) discloses mutual authentication, a first authentication means, a second authentication means, an encryption means and a decryption means. References are provided below.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV reads as follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101  
... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claim 82 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claim 82 defines “storage medium” with descriptive material. While “functional descriptive material” may be claimed as a statutory product (i.e., a “manufacture”) while embodied on a tangible computer readable medium, recording medium embodying that same functional descriptive material is neither a process nor a product (i.e., a tangible “thing”) and therefore does not fall within one of the four statutory class of §101. Rather, “medium” is a form of energy, in the absence of any physical structure or tangible material. Examiner recommends changing “A storage medium or a removable storage medium.....” to “A computer readable storage medium or a computer readable removable storage medium on which a program is recorded.....”.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negatived by the manner in which the invention was made.

Claims 6, 10, 13, 18, 21, 22, 23, 26, 29, 42, and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al (US 6810200) in view of Kamibayashi et al (US 6847950).

Regarding **claim 6** Aoyama et al discloses a playback/recording apparatus for performing transfer of contents recorded on an erasable storage medium, between apparatuses:

    said playback/recording apparatus comprising a playback/erasing apparatus as a first apparatus (fig 2, 1080 and 1071, col 6, lines 10 – 16, illustrates the combination of CD 1080 and data storage unit 1071 as playback and fig 2, 1070, col 6, lines 10 – 24 deletes the data, comprise the first apparatus) a recording apparatus as a second apparatus (fig 2, 1070 and 1090, and fig 3, 1200 and 1090, col 6, lines 55 – 61, comprise recording apparatus) and a transmission line such as a transmission cable or the like for connecting the first and second apparatuses (fig 3, 1090, col 6, lines 65 – 67, SD card 1090 loads music data and becomes the transmission media)

    said first apparatus comprising:

        transfer of contents between itself and the second apparatus (col 11, lines 1 – 8, illustrates copying of data from CD to HD and SD card)

        a playback means for reproducing contents recorded on a first storage medium (fig 2, 1010, col 5, lines 41 – 43 reads data from CD) and outputting the reproduced contents (col 6, lines 10 – 15, outputs the reproduced contents on SD and data storage)

        a detection means for detecting copyright information of the contents (fig 2,

1020, col 5, lines 60 – 67, judges or detects copyright information)

an erasing means for erasing the contents from the first storage medium (col 10, lines 9 – 13, illustrates data from HD being deleted as soon as it is written onto SD card)

said second apparatus comprising:

transfer of contents between itself and the first apparatus (fig 2, 1020, col 6, lines 5 – 9 illustrates transfer of contents)

a recording means for recording the contents on a second storage means (fig 2, 1090, col 6, lines 5 – 8, writes data on SD card)

wherein, when performing transfer of the contents, the contents are reproduced by the playback means and outputted and, the contents are erased from the first storage medium by the erasing means, and the contents are recorded on the second storage means by the recording means, thereby transferring the contents. (rejected based on the information contained above)

However Aoyama et al does not disclose a first and second authentication means for performing mutual authentication, an encryption means for encrypting the output from the playback and a decryption means for decrypting the encrypted data

On the other hand Kamibayashi et al teaches a first and second authentication means for performing mutual authentication (first authentication fig 5, 6c, second authentication fig 5, 13d and mutual authentication fig 5, col 7, lines 58 - 65, col 8, line 24 to col 9 line 40) an encryption means for encrypting the output from the playback (col 5, lines 29 – 31) and a decryption means for decrypting the encrypted data (col 12, lines 4 – 9)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a first and second authentication means for performing mutual authentication, an encryption means for encrypting the output from the playback and a decryption means for decrypting the encrypted data as taught by Kamibayashi et al in the system of Aoyama et al in order to be accessible by secret specific procedures.

Regarding **claim 21** Aoyama et al discloses the playback/recording apparatus defined further comprising a temporary storage means for temporarily storing the contents; wherein the contents are temporarily stored in the temporary storage means (fig 2, 1071, col 6, lines 5 – 9 illustrate HD as temporary storage)

Regarding **claim 26** Aoyama et al discloses the playback/erasing apparatus as the first apparatus further comprising a first control means for controlling the playback means (fig 2, 1010, col 5, lines 41 – 43) and erasing means (fig 2, 1070, col 6, lines 20 – 24 illustrates deleting data); wherein the playback means and erasing means are controlled by the first control means, thereby performing transfer of the contents. (fig 2, 1010 and 1070 together with 1020 perform transfer of contents)

**Claims 10, 13 and 18** are rejected based on claim 6 above

**Claims 22 and 23** are rejected based on claim 21 above

**Claims 29, 42, and 82** are rejected based on claim 26 above

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

Ogino (US 6433946) discloses method and device for controlling information signal recording.

Yamamoto et al (US 6904227) discloses device and method for editing video and/or audio data recorded in a disc storage medium.

Hirai (US 6839503) discloses transfer apparatus and recording control system using a transfer control method selected based on a transfer rate of data.

Kawamae et al (US 6578149) discloses a method for producing data, apparatus for reproducing data, method for coding data, method for recording data.

Kori et al (US 6480607) discloses an encrypted reproducing transmitting and processing method and apparatus with separately encrypted control data.

Ogino (US 6427047) discloses an apparatus and method for detecting the unauthorized duplication of a signal.

Kori et al (US 5778064) discloses an apparatus and method for processing a high definition video signal.

Kim et al (US 5799081) discloses an illegal view/copy protection method and apparatus for digital broadcasting system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.Y.H.  
04/08/2008

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621